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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/626,600	04/02/1996	MICHAEL F. QUINN	107040.007	8034

27510 7590 12/31/2002

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/626,600

Applicant(s)

QUINN ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 29, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-43 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

1. Claims 1-12, 14-27 and 29-32 are canceled.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-37, 39-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cukor and Reding.
4. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cukor and Reding as applied to claim 33 above, and further in view of Dysart.
5. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cukor and Reding as applied to claims 35 and 36 above, and further in view of Wang.

Features recited in the instant claims were addressed in the prior Office actions, BAPI and the Examiner's Answer. Applicant is referred to these prior actions.

Applicant argues that the Board and the Examiner fail to consider arguments that distinguished the present invention over the cited prior art because it was determined that these

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points of distinction were not specifically recited in the claims. Applicant has cited page 12, first full paragraph of the BPAI Decision. Applicants then amend the claims to recite the capacity of local memories and the process of determining if a requested document is stored locally before requesting the data from a central site.

In response, applicant's arguments that Cukor does not provide sufficient memory for storing documents or for long term storing is not persuasive. Cukor clearly teaches a storage for storing documents. There are no such assertion in Cukor itself of the size of their memory capacity. Absent a teaching is not an indication that a feature is non-obvious. Applicant is reminded that:

*In re Bozek*, 163 USPQ 545 (CCPA 1969) "Reference disclosure must be evaluated for **all that it fairly suggests** and not only for what is indicated as preferred."

*In re Jacoby*, 135 USPQ 317 (CCPA 1962) "Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be **presumed to know something** about radiators **apart from what references disclose**" "it is immaterial that reference does not disclose specific function set forth in applicant's specification, since this is merely an additional **attribute possessed by reference structure** which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it"

*Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CA FC 1989)

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A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including **non-preferred embodiments**.

Furthermore, Cukor et al at the time of filing, available memory capacity was limited. Cukor does not specify the size or scanned documents or the storage capacities of files or documents. Thus, Cukor would have taken great care in avoiding erasure of important financial documents in their local memories. See column 6, lines 43-48. Applicant's statement that "[A]t the beginning of the next day, those documents stored on the 80 megabytes of memory will presumably be overwritten by that day's documents" is not stated in Cukor. This unsupported statement made by applicant is not convincing because Cukor ensures that sufficient memory is available for a particular day's transaction. Moreover, Cukor states that "the remote stations include means 26 for communicating document images and related information back and forth with the central processing site". (Column 7, second full paragraph). Thus, overwritten a day's transactions would not have occurred in the system of Cukor.

As per applicant's argument that Cukor's system does not check to determine if the requested document is stored locally before requesting the data from the central processing site because a temporary file is erased the next day is not convincing because it is not required that the memory is completely full for all transactions occurring for a given day. Transactions are transmitted to a particular location where all transaction processing can be taken place.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The Examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone number for this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

FP

14Dec02



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3628**